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EXAMINER

TSOY, ELENA

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 11/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

11/3/15

Office Action Summary

Application No.

09/332,273

Applicant(s)

MIENTUS ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-80 is/are pending in the application.
- 4a) Of the above claim(s) 66-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-65 and 74-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Response to Amendment

1. Amendment filed on October 7, 2002 has been entered. Claims 29-37 have been cancelled. New claims 78-80 have been added. Claims 42-80 are pending in the application. Claims 66-73 are withdrawn from consideration as directed to a non-elected invention.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Rejection of claims 49, 52 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. **Claims 42-46, 52, 74, 75** are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 4,946,532) for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on August 2, 2002 (Paper No. 7).

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6. **Claims 49, 50, 53, 54** are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 4,946,532) in view of McHenry et al (US 4,525,134) for the reasons of record as set forth in Paragraph No. 9 of the Office Action mailed on August 2, 2002 (Paper No. 7).
7. **Claim 51** is rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 4,946,532) in view of Fukushima et al (US 4,542,061) for the reasons of record as set forth in Paragraph No. 10 of the Office Action mailed on August 2, 2002 (Paper No. 7).
8. **Claims 55-63** are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 4,946,532) in view of McHenry et al (US 4,525,134), as applied above, and further in view of Fukushima et al (US 4,542,061) for the reasons of record as set forth in Paragraph No. 11 of the Office Action mailed on August 2, 2002 (Paper No. 7).
9. **Claims 47, 48, 76, 77** are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 4,946,532) in view of Bingham (US 3,758,192) for the reasons of record as set forth in Paragraph No. 12 of the Office Action mailed on August 2, 2002 (Paper No. 7).
10. **Claims 64, 65** are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 4,946,532) in view of McHenry et al (US 4,525,134), further in view of Fukushima et al (US 4,542,061), as applied above, and further in view of Bingham (US 3,758,192) for the reasons of record as set forth in Paragraph No. 13 of the Office Action mailed on August 2, 2002 (Paper No. 7).
11. **Claims 78, 80** is rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 4,946,532) for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on August 2, 2002 (Paper No. 7) since Freeman teaches that a multilayer film can be

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stretched (oriented) for **most** applications (See column 3, line 43) meaning that for *some* applications it may be unoriented (not stretched).

12. **Claim 79** is rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 4,946,532) in view of McHenry et al (US 4,525,134), as applied above, and further in view of Fukushima et al (US 4,542,061) for the reasons of record as set forth in Paragraph No. 11 of the Office Action mailed on August 2, 2002 (Paper No. 7), as was discussed above for claims 78, 80.

Response to Arguments

13. Applicants' arguments filed October 7, 2002 have been fully considered but they are not persuasive.

(A) Applicants argue that claimed invention is novel over Freeman because although Freeman generally teaches that the first skin layer may have controlled surface texture, whether gloss or matte, Freeman fails to teach that it has the initial 60⁰ gloss of about 80 or more. It appears that the Examiner takes the position that the Freeman skin layer would inherently exhibit the initial gloss value as claimed.

The Examiner respectfully disagrees with this argument. The Examiner did not take the position that the Freeman skin layer would exhibit the initial gloss value as claimed inherently. Instead, the Examiner clearly stated in the last Office Action that "It would have been **obvious** to one of ordinary skill in the art at the time the invention was made to have provided a first skin layer in a multilayer thermoplastic film of Freeman with **any** degree of gloss including claimed initial 60⁰ gloss is about 80 or more depending on the intended use of the film since Freeman

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teaches that the first skin layer (made of the same material as claimed one) may be provided with any surface texture, whether **gloss** or **matte**."

It is held that, generally, differences in any parameter will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such a parameter is **critical**. In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969) (Claimed elastomeric polyurethanes which fell within the broad scope of the references were held to be unpatentable thereover because, among other reasons, there was no evidence of the **criticality of the claimed ranges** of molecular weight or molar proportions.). For more recent cases applying this principle, see Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989); In re Kulling, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990); and In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).

In present case, general conditions of claim, namely a skin layer having (any) gloss value is disclosed by Freeman (See column 9, lines 54); and, moreover, the specification fails to teach **criticality** of the claimed range of 80 or more of 60⁰ gloss.

It is held that the prior art can be modified or combined to reject claims as prima facie obvious as long as there is a **reasonable expectation of success**. In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). See MPEP 2143.02.

The skin layer in Freeman is comprised of the same material as claimed one (See the specification, page 10, lines 30-33), namely, of ionomer derived from sodium, or zinc salts of ethylene methacrylic acid copolymer (See column 10, lines 33, 41-44). Therefore, one of ordinary skill in the art would have **reasonable expectation of success** in providing the skin layer of Freeman with any desired gloss value depending on intended use.

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(B) Applicants argue that claimed invention is novel over combination of Freeman with other references, McHenry et al, Fukushima et al due to deficiencies of Freeman.

The Examiner respectfully disagrees with this argument for the reasons, discussed above.

(C) Applicants argue that claimed invention is novel over combination of Freeman with Bingham since i) the examiner has not cited any prior art that would suggest including an opacifying layer between the core layer and the second skin layer in Freeman; ii) Bingham relates to reflect-reflective structures containing beads; and

This argument is not persuasive.

As to i), Bingham teaches that an adhesive layer 18 behind a binder layer 17 a multilayer signage film (See column 1, lines 7-8) may be pigmented to serve as coloring or opacifying layers (See column 3, lines 11-14) in order to reinforce or complement the color of the binder layer 17 (See Figs. 3, 5; column 4, lines 16-26). Thus, Bingham is the prior art that would suggest including an opacifying layer between the core layer and the second skin layer in a multilayer signage film of Freeman in order to reinforce or complement the color of a binder layer.

As to ii), first of all, claims 47, 48, 76, 77 do not exclude other components such as glass beads in layers of claimed multilayer signage film. Secondly, the fact that Bingham relates to reflect-reflective structures containing beads is irrelevant because the pigmented coloring or opacifying adhesive layer 18 placed behind a binder layer in a multilayer signage film would reinforce or complement the color of any binder layer whether the binder has or does not have other components such as glass beads.

Conclusion

14. As to claims 42-65, 74-77, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. As to claims 78-80, Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (703) 605-1171. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

ET

Elena Tsoy
Examiner
Art Unit 1762

October 31, 2002


MICHAEL BARR
PRIMARY EXAMINER